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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,279	05/31/2001	Eugene C. Nelson	32668	8624
116	7590	04/21/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			STIMPAK, JOHNNA	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,279

Applicant(s)

NELSON, EUGENE C.

Examiner

Johnna R Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/31/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/31/01</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The following is a first office action upon examination of application number. Claims 1-11 are pending and have been examined on the merits discussed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what an unrelated verbatim is. While there is brief mentioning of an unrelated verbatim, the specification is directed to a verbatim wherein each survey is customized according to actual responses of the participant, i.e., each question is linked to the previous question. Please clarify. For purposes of examination, examiner construes an unrelated verbatim to be standard questions asked of all survey participants such as name, address, contact information wherein the user is asked to supply information for each independent of how the previous was answered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. **Claims 1, 2, 5, 8, 9 and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by Peters et al, US 5,893,098.

As per **claim 1**, Peters et al teaches a first questioning series of core item questions developed to support a survey purpose (column 5, lines 54-65 – a first series of questions are asked); and a second questioning series of drill-down questions, wherein each of the drill-down questions is associated with one of the core item questions and one of the drill-down questions is presented only when a response to the associated core item question meets a specified criterion (column 5, lines 54-65 – the first questions include branched-to questions linked to the first questions wherein the user is only required to answer the branched-to question if the user gives a predetermined answer to the first questions).

As per **claim 2**, Peters et al teaches the system is an automated one (column 2, lines 55-67 and column 6, lines 1-5 – the system is automated in that there is a screen presenting the questions to the user wherein the survey is dynamic in that it only presents questions to the user if the user has made a predetermined answer – it automatically links to the next appropriate question).

As per **claim 5**, Peters et al teaches presenting a first core item question and recording a response to the first core item question; interpreting the first core item response; presenting at least one drill-down question and recording a response to the drill-down question only if the first core item response meets a specified criterion; and presenting a second core item question and recording a response to the second core item question (column 5, lines 54-65 – the first questions include branched-to questions linked to the first questions wherein the user is only required to answer the branched-to question if the user gives a predetermined answer to the first questions).

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Claims 8 and 9 are written in means-plus-function format and for the purpose of this rejection are being treated as though they were method claims. The courts have held that such treatment is acceptable:

"If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions, the apparatus claim is an attempt to exalt form over substance since the claim is really to the method or series of functions itself. In computer-related inventions, the recited means often perform the functions of "number crunching" (solving mathematical algorithms and making calculations). In such cases the burden must be placed on the applicant to demonstrate that the claim is truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions."

If this burden has not been discharged, the apparatus will be treated as if it were drawn to the method or process which encompasses all of the claimed "means." See In re Abele 214 USPQ 682, 688 (CCPA 1982); Ex parte Akamatsu, 22 USPQ 2d 1915, 1920; and Ex parte Alappat, 23 USPQ 2d 1340, 1344.

As per **claim 8**, it is the means for performing the method of claim 5 and therefore the same rejection as applied to claim 5 also applies to claim 8.

As per **claim 9**, it is the means for performing the method of claim 6 and therefore the same rejection as applied to claim 6 also applies to claim 9.

As per **claim 11**, Peters et al teaches presenting a second drill-down question and recording a response to the second drill-down question only if the response to the drill-down question meets a specified criterion; and presenting a second core item question and recording a response to the second core item question. (column 5, lines 54-65 – each question includes a branched-to question that is linked to the question wherein the user is only required to answer the branched-to question if the user gives a predetermined answer to the question).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3, 4, 6, 7 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al in view of Nanos et al, US 6,381,744.

As per **claim 3**, Peters et al teaches allowing the user to enter text to answer more complicated questions but does not explicitly teach the second questioning series contains at least one verbatim question presented only when a response to a previous question meets a specified criterion and wherein a detailed response to the verbatim question may be given to further explain the response to the previous question. However, Nanos et al teaches an automated survey system wherein selecting a response takes the user to the next question but also includes open ended questions wherein the user can record his or her answers by using a microphone as opposed to selecting a single answer. Since both Peters et al and Nanos et al both teach automated surveys where questions are linked together it would have been obvious to one of ordinary skill in the art at the time of the invention to include Nanos et al's feature wherein the user can answer a question in his or her own words using a microphone. This allows the user to convey the answer to the survey in his or her own words.

As per **claim 4**, Peters et al teaches allowing the user to enter text to answer questions, but does not teach the system includes a device for recording a response to a verbatim question literally. However, Nanos et al teaches an automated survey system wherein selecting a response

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takes the user to the next question but also includes open ended questions wherein the user can record his or her answers by using a microphone as opposed to selecting a single answer. Since both Peters et al and Nanos et al both teach automated surveys where questions are linked together it would have been obvious to one of ordinary skill in the art at the time of the invention to include Nanos et al's feature wherein the user can answer a question in his or her own words using a microphone. This allows the user to convey the answer to the survey in his or her own words.

As per **claim 6**, Peters et al does not explicitly teach interpreting the response to the drill-down question; and presenting at least one verbatim and recording a verbatim response if the drill-down response is not within the predetermined acceptable response range. Nanos et al teaches allowing the user to answer a question by opting to record a verbal response if the list of answers is not provided in the list of prompted answers. The user can record his or her answers by using a microphone as opposed to selecting a single answer. Since both Peters et al and Nanos et al both teach automated surveys where questions are linked together it would have been obvious to one of ordinary skill in the art at the time of the invention to include Nanos et al's feature wherein the user can answer a question in his or her own words using a microphone. This allows the user to convey the answer to the survey in his or her own words.

As per **claim 7**, Peters et al does not teach presenting at least one unrelated verbatim and recording an unrelated verbatim response, wherein the unrelated verbatim does not depend upon a previous response. However it is old and well known to collect information such as name, address, contact information, etc., from each survey participant. It is obvious that each person would be asked each question independent of how the previous question was answered. For

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example, when asked to supply a name, the system would automatically proceed to address independent of what information was supplied for name. These types of unrelated, unlinked questions allow for specific information to be supplied and are not based on answers to previous questions.

As per **claim 10**, Peters et al teaches allowing the user to enter text to answer more complicated questions but does not explicitly teach a verbatim is presented when the participant does not answer a second series question within the acceptable range. However, Nanos et al teaches an automated survey system wherein selecting a response takes the user to the next question but also includes open ended questions wherein the user can record his or her answers by using a microphone as opposed to selecting a single answer. Since both Peters et al and Nanos et al both teach automated surveys where questions are linked together it would have been obvious to one of ordinary skill in the art at the time of the invention to include Nanos et al's feature wherein the user can answer a question in his or her own words using a microphone. This allows the user to convey the answer to the survey in his or her own words.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Donnell, US 6,032,177 – method and apparatus for conducting an interview between a server computer and a respondent computer

McLaughlin, Rachel. "Surveying customer satisfaction"

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McAndrew et al, US 5,517,405 – expert system for providing interactive assistance in solving problems such as health care management.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R Stimpak whose telephone number is 571-272-6736.

The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS
4/18/05



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600